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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DESAL, RITA J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,973

Applicant(s)

OHMOTO ET AL

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-18 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/083)
Paper No(s)/Mail Date 3/02/07, 12/22/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants have elected group V of the restriction and have added new claims 23-25.

Amended claim 14 to depend from claim 23.

Claims 1-13, 19-21 have been withdrawn .

Claim 22 has been cancelled.

Claims under consideration are the compound claims 23-25 and their pharmaceutical compositions 14-18.

According to the formula of claim 23 the examiner has made the following groups.

V(a) , claims 23-25, 14-18 drawn to compounds and composition wherein A3 is a benzene , pyridine, pyrazine or a pyrimidine and R6 and R7 do not form a ring and R2, R3, R6 and R7 are each independently C1-8 alkyl, C2-8 alkenyl, C2-8 alkynyl, a hydroxyl, C 1-8 alkoxy, mercapto, C1-8 alkylthio, amino, NR104R105, carboxyl, C1-6 alkoxycarbonyl, nitro, cyano, a halogen atom, oxo, acyl, formyl or tri(C 1-6alkyl)silyl. (formula I-3-2 and not I-3-4 which requires both R4R5 and R6R7 to form a ring.)

V(b) , claims 23, 24, 14-18 drawn to compounds and compositions wherein R6 and R7 also forms a ring along with R4 and R5 and R2 and R3 are each independently C1-8 alkyl, C2-8 alkenyl, C2-8 alkynyl, a hydroxyl, C 1-8 alkoxy, mercapto, C1-8 alkylthio, amino, NR104R105, carboxyl, C1-6 alkoxycarbonyl, nitro, cyano, a halogen atom, oxo, acyl, formyl or tri(C 1-6alkyl)silyl.

The elected species of claim 25 falls within the group V(a) and the examination on the same follows.

Information Disclosure Statement

The information disclosure statement filed 12/22/05 fails to comply with 37 CFR

1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information

referred to therein has not been considered. The copies that have not been supplied have not been considered and has been lined through.

Claim Rejections - 35 USC § 112

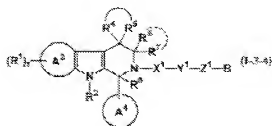
The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23,24, 14-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain compounds wherein X1, Z1 are bonds and Y1 is a C=O, R4 and R5 from a cyclo propane (cyclic ring) without any substituents. B is an alkyl without any substituents, R4 is a phenyl substituted by a halogen, t is o, and R6 and R7 are H, does not reasonably provide enablement for all the other various substituents for X1, Y1, Z1, B, R6, R7, R1, nor the solvates or prodrugs of the same. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

1) The breadth of the claims: The instant claims encompass many compounds within the



formula , wherein all the variables have many options and substituents. The core keeps changing with the variables and gives rise to numerous permutations and combinations.

2) The nature of the invention: The invention is a chemical compound used as a pharmaceutical.

3) The state of the prior art: The state of the prior art is that the drugs and the enzymes react in a lock and key mechanism and the structure of the compound has to be specific. Even a difference of a methyl group versus a hydrogen changes the properties altogether. A good example is a theophylline versus caffeine. They differ by just a methyl group but one of them has a pharmaceutical use as a bronchodilator. There is no absolute predictability and no established correlation between the different substitutions on a core that they would all behave in the exact same way. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

Also the state of the prior art is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities. There is no absolute predictability and no established correlation between in vitro activity and the treatment of diseases as the in vitro data is not a reliable predictor of success even in view of the seemingly high level of skill in the art.

4) The level of one of ordinary skill: The ordinary artisan is highly skilled.

5) The level of predictability in the art:

Regarding how to use:- It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In *re Fisher*, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. The level of unpredictability is in the art is very high. The compounds which differ by a methyl group also show different properties, for e.g. theophylline and caffeine. One of them is a bronchodilator and they differ only by a methyl group. See *In re Fisher*, 166 USPQ 18, at 24 (In cases involving unpredictable factors, such as

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most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.), *Nationwide Chemical Corporation, et al. v. Wright, et al.*, 192 USPQ 95 (one skilled in chemical and biological arts cannot always reasonably predict how different chemical compounds and elements might behave under varying circumstances), *Ex parte Sudilovsky* 21 USPQ2d 1702 (Appellant's invention concerns pharmaceutical activity. Because there is no evidence of record of analogous activity for similar compounds, the art is relatively unpredictable) *In re Wright* 27 USPQ2d 1510 (the physiological activity of RNA viruses was sufficiently unpredictable that success in developing specific avian recombinant virus vaccine was uncertain).

Regarding how to make :-

As stated in the preface to a recent treatise:

"Most non-chemists would probably be horrified if they were to learn how many attempted syntheses fail, and how inefficient research chemists are. The ratio of successful to unsuccessful chemical experiments in a normal research laboratory is far below unity, and synthetic research chemists, in the same way as most scientists, spend most of their time working out what went wrong, and why. Despite the many pitfalls lurking in organic synthesis, most organic chemistry textbooks and research articles do give the impression that organic reactions just proceed smoothly and that the total synthesis of complex natural products, for instance, is maybe a labor-intensive but otherwise undemanding task. In fact, most syntheses of structurally complex natural products are the result of several years of hard work by a team of chemists, with almost every step requiring careful optimization. The final synthesis usually looks quite different from that originally planned, because of unexpected difficulties encountered in the initially chosen synthetic sequence. Only the seasoned practitioner who has experienced for himself the many failures and frustrations which the development (sometimes even the repetition) of a synthesis usually implies will be able to appraise such workChemists tend not to publish negative results, because these are, as opposed to positive results, never definite (and far too copious) " Dorwald F. A.

Side Reactions in Organic Synthesis, 2005, Wiley: VCH, Weinheim pg. IX of Preface.

Thus it is not very easy to synthesize compounds, and that there is very little predictability in the art of synthesis and using the compounds.

6) The amount of direction provided by the inventor: The inventor provides very little direction in the instant specification. Compound 7-20 on pages 22 and 23 fall within the scope of the elected group. The only substituents are that of fluorine on the R4 phenyl, 7 or 2 acetyl group. Compounds 48-61 on pages 24, 25. also show the methyl and the fluoro substituents.

Test data for example 17 only has been shown. The availability of the starting material that is needed to prepare the invention as claimed is at issue here. As per MPEP 2164.01 (b): A key issue that can arise when determining whether the specification is enabling is whether the starting materials or apparatus necessary to make the invention are available. In the biotechnical area, this is often true when the product or process requires a particular strain of microorganism and when the microorganism is available only after extensive screening. The Court in *In re*

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Ghiron, 442 F.2d 985, 991, 169 USPQ 723, 727 (CCPA 1971), made clear that if the practice of a method requires a particular apparatus, the application must provide a sufficient disclosure of the apparatus if the apparatus is not readily available. The same can be said if certain chemicals are required to make a compound or practice a chemical process. In re Howarth, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981).

Regarding solvates:- The claims are drawn to solvates, yet the numerous examples presented all failed to produce a solvate. These cannot be simply willed into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190 "The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity. However ... there is no evidence that such compounds exist... the examples of the '881 patent do not produce the postulated compounds... there is ... no evidence that such compounds even exist." The same circumstance appears to be true here. There is no evidence that solvates of these compounds actually exist; if they did, they would have formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly.

Regarding Prodrugs :- Predicting if a certain ester of a claimed alcohol, for example, is in fact a prodrug, that produces the active compound metabolically, in man, at a therapeutic concentration and at a useful rate is filled with experimental uncertainty. Although attempts have been made to predict drug metabolism *de novo*, this is still an experimental science. For a compound to be a prodrug, it must meet three tests. It must itself be biologically inactive. It must be metabolized to a second substance in a human at a rate and to an extent to produce that second substance at a physiologically meaningful concentration. Thirdly, that second substance must be clinically effective. Determining whether a particular compound meets these three criteria in a clinical trial setting requires a large quantity of experimentation. Wolff (Medicinal Chemistry) summarizes the state of the prodrug art. Wolff, Manfred E. "Burger's Medicinal Chemistry, 5ed, Part I", John Wiley & Sons, 1995, pages 975-977. The table on the left side of page 976 outlines the research program to be undertaken to find a prodrug. The second paragraph in section 10 and the paragraph spanning pages 976-977 indicate the low expectation of success. In that paragraph the difficulties of extrapolating between species are further developed. Since, the prodrug concept is a pharmacokinetic issue, the lack of any standard pharmacokinetic protocol discussed in the last sentence of this paragraph is particularly relevant. Banker (Modern Pharmaceuticals) Banker, G.S. et al, "Modern Pharmaceuticals, 3ed.", Marcel Dekker, New York, 1996, pages 451 and 596. In the first sentence, third paragraph on page 596 states that "extensive development must be undertaken" to find a prodrug.

7) The existence of working examples: The instant specification does not have any working examples with respect to the various substituents as given above and also the data is provided for only compound 17.

8) The quantity of experimentation needed to make or use the invention based on the content of the disclosure: In view of all the above factors, guidance and state of the art, it would require an undue amount of experimentation to make the invention of the claims with various substituents, or its solvates or prodrugs.

Taking the above eight factors into consideration, it is not seen where the instant specification enables the ordinary artisan to make and/or use the instantly claimed invention.

Genetech Inc Vs Nova Nordisk 42 USPQ 2d 1001.

"A patent is not a hunting license. It is not a reward for search but compensation for its successful conclusion and patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable."

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In *re* Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to practice Applicants' invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-25, 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 11/722623 or US PUB 20080114012. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope is different. However the scope of the claimed invention is encompassed by the claims in the co-pending application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Claims 23-24, 14-18 stand rejected.

Claim 25 is object to as being dependent from a rejected claim.

Claims 1-13, 19-21 have been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

May 7, 2009